

3. Remarks.

A. The amendments made.

No amendments have been made in the preceding section.

In the event that this specification or claims should require any further amendment, the kind assistance of the Examiner in entering an Examiner's amendment will be greatly appreciated. It is suggested that such amendment may be optionally supplemented by a phone conversation and confirmed by form PTOL-327, Box 4b, so as to expedite the formal allowance of this application.

B. The Office action.

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The last Office Action mailed from the Patent Office on October 16, 2006 has been carefully considered, and indicates that:

- Claims 1 and 4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- Claims 1 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Nelson *et al.*

C. The response.

- (1) *The rejection of claims 1 and 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

In response to the Examiner's rejection of claims 1 and 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, Tetenes respectfully submits that the "sheet material" referred to in lines 29 and 38 of claim 1 refer to the --cylindrical containing component--.

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In view of clarification made regarding the "sheet material" referred to in lines 29 and 38 of claim 1 referring to the --cylindrical containing component--, Tetenes respectfully submits that the Examiner's grounds for the rejection of claims 1 and 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention are no longer applicable and therefore Tetenes respectfully requests that the Examiner withdraw this rejection.

(2) *The rejection of claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Nelson et al.*

In response to the Examiner's rejection of claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Nelson *et al.*, Tetenes respectfully submits that the Federal Circuit holds that relevant case law must be relied upon in determining obviousness; the determination of obviousness is a matter of law.¹

¹ *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d (BNA) 1210, 1214 (Fed. Cir. 1995) ("Obviousness is a question of law, which we review *de novo*, though factual findings underlying the Board's obviousness determination are reviewed for clear error. *In re Vasck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990)."**[Emphasis added]**); *Richardson-Vicks Inc. v. The Upjohn Co.*, 122 F.3d 1476, 44 USPQ2d 1181 (Fed. Cir. 1997) ("The difficulty with RVT's position is that, although the argument has merit when the issue is purely one of fact, it does not follow when the issue involves a question of law. It is black letter law that the ultimate question of obviousness is a question of law." See *Graham v. Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) (citing *Great A. & P. Tea Co. v. Supermarket Equip. Co.*, 340 U.S. 147, 155, 87 USPQ 303, 309 (1950)); *In re Donaldson Co.*, 16 F.3d 1189, 1192, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (*in banc*); *Texas Instruments Inc. v. Unit States Int'l Trade Comm'n*, 988 F.2d 1165, 1178, 26 USPQ2d 1018, 1028 (Fed. Cir. 1993). And we review that legal question without deference to the trial court. See *Gardner V. TEC Sys. Inc.*, 725 F.2d 1338, 1344, 220 USPQ 777, 782 (Fed. Cir. 1984) (district court's conclusion on obviousness "is one of law and subject to full and independent review in this (continued...)")

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In the seminal case of *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684 (1966), the Supreme Court articulated the requirements for a *prima facie* holding of obviousness. The Patent Office has since set forth in *MPEP* § 706.02 a three step requirement for establishing a *prima facie* case of obviousness. The first step requires that the Examiner must set forth the differences in the claim over the applied references. The second step requires that the Examiner must set forth the proposed modification of the reference that would be necessary to arrive at the claimed subject matter. And, the third step requires that the Examiner must explain why the proposed modification would be obvious.

The Courts require that in order to satisfy the third step for establishing a *prima facie* case of obviousness, the Examiner must identify where the prior art provides a motivating suggestion to make the modifications proposed in the second step for establishing a *prima facie* case of obviousness.²

¹ (...continued)
court")."([Emphasis added])).

² *In re Jones*, 958, F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992) ("The Solicitor points out that, given the breadth of forms of dicamba (free acid, ester, or salt) disclosed by Richter as having herbicidal utility, one of ordinary skill in the art would appreciate that the dicamba group has significance with respect to imparting herbicidal activity to dicamba compounds. Thus, the solicitor contends, one skilled in the art would have been motivated to use, with dicamba, substituted ammonium salts made from a known amine, such as the amine disclosed by Zorayan and Wideman, and would have expected such a salt to have herbicidal activity. Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." *In re Fine*, 837 F.2d 1071, 1074, 3 USPQ 2d 1596, 1598-99 (Fed. Cir. 1988). We see no such suggestion in Zorayan, which is directed to shampoo additives, nor Wideman, which teaches that the amine used to make
(continued...)

The Courts require, however, that even if the prior art may be modified as suggested by the Examiner, the modification is not made obvious unless the prior art suggests the desirability of the modification.³

In properly applying the *Graham v. John Deere Co.* test, the Examiner must conduct a rigorous examination and analysis of the prior art. Neither Roberts nor Nelson *et al.* make any motivating suggestion that:

- Regarding claim 1, the device of Roberts can be modified to have added thereto the drawstring taught by Nelson *et al.*, as suggested by the Examiner.⁴
- Regarding claim 4, the device of Roberts can be modified to have added thereto the foam flotation element of Nelson *et al.*, as suggested by the Examiner.⁵

² (...continued)

the claimed compound is a byproduct of the production of morpholine. Nor does the board disclosure of Richter fill the gap, for the reasons discussed above." [Emphasis added]); *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 912 F.Supp. 422, 38 USPQ.2d 1300 (W.D.Ark. 1996) ("The existence of separate elements of the invention in the prior art is insufficient to establish obviousness, absent some teaching or suggestion in the prior art to combine the elements." [Emphasis added]); *Gambro Lundia AB v. Baxter Healthcare Corporation*, 110 F.3d 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997) ("Without a suggestion or teaching to combine, a case of obviousness is deficient." [Emphasis added]). See *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ.2d 1377; *In re Fine*, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

³ *In re Fritch*, 922, F.2d 1260, 23 USPQ.2d 1780, 1783 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127." [Emphasis added]).

⁴ Page 5, ¶ 1, lines 1-2 of the last Office action.

⁵ Page 5, ¶ 2, lines 3-5 of the last Office action.

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The Examiner has merely combined elements in a piecemeal manner in light of Tetenes' disclosure to show obviousness by using Tetenes' own specification as though it were prior art, and in doing so, has violated the basic mandate inherent in 35 U.S.C. § 103.⁶

Let's say hypothetically, however, that there is a motivating suggestion to modify the device of Roberts to have added thereto the drawstring taught by Nelson *et al.*, which Tetenes does not contend, a holding of obviousness can still not be made out because modify the device of Roberts to have added thereto the drawstring taught by Nelson *et al.* would prevent Roberts from functioning in its intended manner, and the Board refused to uphold a rejection on obviousness because the rearrangement of the prior-art device prevented the device from functioning in the intended manner.⁷

An intended manner of functioning of the device of Roberts is to function also as a seat.⁸

⁶ CFR § 1.107(b) ("When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons."[Emphasis added]).

⁷ *Ex parte Weber*, 154 USPQ 491 ("Rearrangement of prior machine would so alter its construction and mode of operation that it would not function in its intended manner; obviousness of proposed changes is not derived from cited prior art but from applicant's disclosure."[Emphasis added]).

⁸ Col. 1, lines 6-7 of Roberts ("* * * when collapsed the bag may be utilized as a seat."[Emphasis added]).

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This is accomplished by making the cover forming the upper end of the container 1 to lie *flat and taunt* when closed. In order for this to occur, the cover is made from a pair of semi-circular sheets 13 having their arcuate edges attached to the tube 6 and their straight edges replaceably attached to each other by a conventional zipper 15.⁹

Replacing the conventional zipper 15 of Roberts with the drawstring of Nelson *et al.* would prevent the cover forming the upper end of the container 1 of Roberts from lying *flat and taunt* so as to provide a seat as required for an intended manner of functioning of Roberts. The drawstring of Nelson *et al.* creates puckering where it passes through the material. The drawstring and the puckered material would not provide a surface desirable to sit on.

Thus, modifying the device of Roberts to have added thereto the drawstring taught by Nelson *et al.* would prevent the device of Roberts from functioning in an intended manner, and as such, the combination cannot be used for a holding of obviousness.

Another intended manner of functioning of the device of Roberts is to allow the cover to open largely.¹⁰

⁹ Col. 2, lines 9-21 of Roberts ("The cover forming the upper end of the container 1 is formed from two semi-circular sheets 13 * * * and each having their circular marginal edges secured to the tube 6 * * *. The adjacent straight and parallel edges of the sections 13 of the cover have each secured thereto one section of a conventional zipper 15. When the zipper connects the sections 13 together a taunt sheet of material completely covers the upper open end of the container 1.").

¹⁰ Col. 2, lines 26-28 of Roberts ("* * * when a larger opening is required between the sections 13 and the cover * * *." (Emphasis added)).

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This is accomplished by making the cover open *diametrically*, i.e., via the sections 13, and grabbing and twisting inwardly the opposite sides of the tube 6 to provide sufficient slack in the sections 13 to provide a large opening in the cover.¹¹

Replacing the conventional zipper 15 of Roberts with the drawstring of Nelson *et al.* would prevent the cover of Roberts from being diametrically openable to provide sufficient slack in the sections 13 to provide a large opening in the cover.

Thus, modifying the device of Roberts to have added thereto the drawstring taught by Nelson *et al.* would prevent the device of Roberts from functioning in another intended manner, and as such, the combination cannot be used for a holding of obviousness.

Furthermore, as required by 37 CFR § 1.111(c), claim 1 describes the following advantageous distinctive features that distinguish over and avoid the prior art:

- a) "a toroidal sleeve being fixedly located near said upper edge of said cylindrical containing component" [Emphasis added]
- b) "a welting" and "said edges of said welting are sewn in between said circumference of said circular bottom component and said lower edge of said cylindrical containing component" [Emphasis added]

¹¹ Col. 2, lines 28-33 of Roberts ("* * * one may grasp the opposed sides of the tube 6 and by giving the latter a turn in the direction of the arrow, as shown in Fig. 3 of the drawings, sufficient slack is given to the sections of the cover as will permit of a larger opening therein * * *." [Emphasis added]).

- c) "said toroidal sleeve is fabricated by attaching said first longitudinal edge of said longitudinal area and said second longitudinal edge of said longitudinal area together" [Emphasis added]

When the device for holding a bucket of frozen chum is designed in accordance with these advantageous distinctive features:

- The top is one-piece with the cylindrical containing component by virtue of "a toroidal sleeve being fixedly located near said upper edge of said cylindrical containing component" [Emphasis added].
- An extra layer of protection is provided for the seam of the circular bottom component and the cylindrical containing component by virtue of "a welting" and "said edges of said welting are sewn in between said circumference of said circular bottom component and said lower edge of said cylindrical containing component" [Emphasis added].
- The toroidal sleeve cannot unintentionally separate from the cylindrical containing component by virtue of "said toroidal sleeve is fabricated by attaching said first longitudinal edge of said longitudinal area and said second longitudinal edge of said longitudinal area together" [Emphasis added].

Turning now to the references, and particularly to Roberts, in contradistinction regarding advantageous distinctive feature a) of claim 1 discussed above, Roberts does not teach "a toroidal sleeve being fixedly located near said upper edge of said cylindrical containing component" [Emphasis added] as required by advantageous distinctive feature a) of claim 1, but rather Roberts teaches that the tube 6 [relied upon by the Examiner as

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the toroidal sleeve of claim 1¹²) is above the upper edge of the container 1 [relied upon as the cylindrical containing component], as shown in FIGURES 1-3 and 5 of Roberts and as discussed at numerous occurrences throughout Roberts, for example: "[t]he tube 6 is also made from a single sheet of material having its opposite marginal edges sewn together to form a depending rib 7 and the opposite ends of the tube are connected by means of the stitching 8 to form a continuous cylindrical ring. The upper opened end of the container 1 is attached to the rib 7 by means of stitching 1' as shown." [Emphasis added].¹³

With this arrangement of Roberts, the tube 6 can unintentionally separate from the container 1.

In further contradistinction regarding advantageous distinctive feature b) of claim 1 discussed above, Roberts does not teach "a welting" and "said edges of said welting are sewn in between said circumference of said circular bottom component and said lower edge of said cylindrical containing component" [Emphasis added] as required by advantageous distinctive feature b) of claim 1, but rather Roberts teaches no welding at all, just has exposed stitching 4 attaching the bottom 3 [relied upon by the Examiner as the circular bottom component of claim 1¹⁴] to the lower end of the container 1 [relied

¹² Page 3, ¶ 3, line 4-5 of the last Office action.

¹³ Col. 1, lines 43-52 of Roberts.

¹⁴ Page 3, ¶ 3, line 3 of the last Office action.

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upon by the Examiner as the cylindrical containing component of claim 1¹⁵], as shown in FIGURES 1 and 3 of Roberts and as discussed at numerous occurrences throughout Roberts, for example: "The bottom 3 is in the form of a disc * * * having marginal edges connected to the lower end of the latter [container 1] by means of stitching 4." [Emphasis added].¹⁶

With this arrangement of Roberts, there is no extra layer of protection provided for the seam of the bottom 3 and the container 1.

In still further contradistinction regarding advantageous distinctive feature c) of claim 1 discussed above, Roberts does not teach "said toroidal sleeve is fabricated by attaching said first longitudinal edge of said longitudinal area and said second longitudinal edge of said longitudinal area together" [Emphasis added] as required by advantageous distinctive feature c) of claim 1, but rather Roberts teaches that the tube 6 [relied upon by the Examiner as the toroidal sleeve of claim 1] is separate from and independent of the container 1 [relied upon as the cylindrical containing component], as shown in FIGURES 3 and 5 of Roberts and as discussed at numerous occurrences throughout Roberts, for example: "[t]he tube 6 is also made from a single sheet of material having its opposite marginal edges sewn together to form a depending rib 7 and the opposite ends of the tube are connected by means of the stitching 8 to form a

¹⁵ Page 3, ¶ 3, line 2 of the last Office action.

¹⁶ Col. 1, lines 39-42 of Roberts.

continuous cylindrical ring. The upper opened end of the container 1 is attached to the rib 7 by means of stitching 1' as shown."[Emphasis added].¹⁷

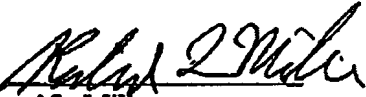
With this arrangement of Roberts, the tube 6 can unintentionally separate from the container 1.

In view of the arguments presented above, Tetenes respectfully submits that the Examiner's grounds for the rejection of claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Nelson *et al.* are no longer applicable and therefore Tetenes respectfully requests that the Examiner withdraw this rejection.

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¹⁷ Col. 1, lines 43-52 of Roberts.